

REMARKS

Claims 1, 2, 4, 5, 7, 8, 10-30, 32, 33, 35-37, 39, 40, 42, and 43 are pending in the present application. Claims 10-29 were previously withdrawn from consideration in response to a restriction requirement. Claims 3, 6, 9, 31, 34, 38, and 41 were previously canceled. Claim 30 has been amended herein to correct a typographical error.

Applicant respectfully traverses the rejection of claims 1, 2, 4, 5, 7, 8, 30, 32, 33, 35-37, 39, 40, 42, and 43 under 35 U.S.C. § 103(a) as obvious over Fredrickson et al., U.S. Patent No. 5,803,594 ("Fredrickson et al.") in view of one or more of Gnaedig, U.S. Patent No. 5,426,888 ("Gnaedig"), Clark Jr., U.S. Patent No. 6,138,406 ("Clark Jr."), and Kono, JP Publication No. 2000-300071 ("Kono").

The PTO "has the burden under § 103 to establish a *prima facie* case of obviousness." *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, the PTO must satisfy three basic criteria. First, the PTO must show that the combined disclosure of the prior art references teaches or suggests all of the claim limitations. See MPEP § 2143 (8th ed., Rev. August 2005). Moreover, it is "incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 USPQ2d 1461, 1462 (Bd. Pat. App. & Inter. 1990).

Second, where obviousness is alleged to arise from a combination of elements across a plurality of references, the PTO must show the existence of some suggestion, motivation, or teaching to those skilled in the art to make the precise combination recited in the claims. See *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1320 (Fed. Cir. 2004). Compliance with this requirement prevents the PTO's use of "the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability — the essence of hindsight." *Ecolchem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1371-72 (Fed. Cir. 2000) (quoting *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)). Evidence of a suggestion or motivation to combine prior art references may come from "the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved." *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000). The PTO's showing "must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not 'evidence.'" *Id.* (quoting *In re Dembiczak*, 175 F.3d at 1000).

Indeed, the U.S. Court of Appeals for the Federal Circuit has consistently held that a person having ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but also some motivation to combine the prior art teachings in the particular manner claimed. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”).

To support a conclusion that a claimed combination is *prima facie* obvious, either (a) the references must expressly or impliedly suggest the claimed combination to one of ordinary skill in the art, or (b) the PTO must present a convincing line of reasoning as to why a person of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985); see also, *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the PTO is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). The PTO must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. *Id.*; *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.”).

Finally, the PTO must demonstrate that a person having ordinary skill in the art would have a reasonable expectation of success when combining the disclosures of the references. The suggestion or motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and must not be derived by hindsight from knowledge of the application’s disclosure. *In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988); MPEP § 2143.

Each of claims 1, 2, 4, 5, 7, 8, 30, 32, 33, 35-37, 39, 40, 42, and 43 recites a plastic simulated rock lawn edging that includes a plurality of hollow middle blocks and two hollow end blocks, each middle and end block including an upper portion and a lower portion, each lower portion including two side edges that extend inwardly towards each other as they extend downward from the upper portion.

Fredrickson et al., U.S. Patent No. 5,803,594, is directed to a method and outdoor light accessory for enhancing the appearance of landscape lighting. It discloses an outdoor light accessory 10 that includes a shell 11 adapted to cover a landscape light fixture 12. (Fredrickson et al. at column 2, lines 17-19.) Fredrickson et al. is not at all directed to landscape edging, and it appears that this reference has been misinterpreted in the claim rejections set forth in the office action dated July 19, 2005, due an to an improper reconstruction of the invention based on hindsight.

For example, page 2 of the office action states that Fredrickson et al. discloses "a plastic living hinge (22 of Figs. 1-3)," when in fact the reference numeral 22 of Fredrickson et al. corresponds to a ground stake tab or flange.

In addition to the foregoing, the illustrated shell 11 includes three ground stake tabs or flanges 21, 22, and 23. They are preferably molded with the rest of the shell 11, and they extend outwardly from the exterior surface 18 in order to rest on the ground 17 when the shell 11 is in place over the fixture 12. They function as means for enabling a user to secure the shell 11 to the ground 17. The user does so by driving a stake into the ground 17 through a hole in each of the flanges 21-23. The stakes are not shown in the drawings, but a commercially available plastic ground stake may be used.

Fredrickson et al. at column 3, lines 12-22 (Emphasis added).

Thus, what the office action characterizes as a disclosure of a "living hinge" is nothing even remotely similar to a living hinge, and instead is related to flanges that are used to secure the shell 11 to the ground using stakes. Indeed, at least in this regard Fredrickson et al. actually teaches away from the invention of the rejected claims, since there would be no reason to have a lower portion with tapered sides that may be anchored into the ground, since separate stakes serve this function in the device disclosed in Fredrickson et al.

In addition, the office action at pages 2-3 states that Fredrickson et al. discloses a lawn edging that includes "each lower portion being tapered (from Fig. 3 in that the lower portion tapers out) and including two edges that extend inwardly towards each other as they extend downward from the upper portion ("edges" are portions 13 in Figs. 1 and 2 that are where lead line of 13 ends) ..." However, this characterization of Fredrickson et al. is wrong on two counts. First, Fig. 3 is a top view and therefore does not show any lower portion of the shell 11 of Fredrickson et al. Second, what the office action characterizes as "edges" of

13 are not even part of the shell 11, but instead are part of a separate structure in the form of a ground stake 13. The teachings of the secondary references do not make up for the deficiencies of Fredrickson et al. with respect to the claims at issue. Thus, even if one were to combine the teachings of Fredrickson et al. with the teachings of Gnaedig, Clark Jr., and Kono, or any combination thereof, one would not arrive at a plastic simulated rock lawn edging as recited in the rejected claims.

Furthermore, there is no motivation to combine a shell 11 of Fredrickson et al. with any of the landscape edging devices of the secondary references.

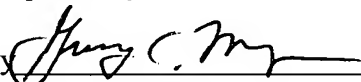
Thus, no *prima facie* case of obviousness has been made in the instant action, and none exists based on the combination of the applied publications. Accordingly, reconsideration and withdrawal of the § 103(a) rejections are respectfully requested.

In view of the above remarks, applicant submits that the application as a whole is in condition for allowance, and such action is requested at the Examiner's earliest convenience.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 13-2855, under Order No. 29939/38771. A duplicate copy of this paper is enclosed.

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Respectfully submitted,

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